

### **REMARKS**

In the Office Action<sup>1</sup> mailed August 4, 2010, the Examiner rejected claims 1-6, 8-12, 20, 22-29, 31-35, 43, 45-52, 54-58, 66, 68-75, 77-81, 89, 91, and 92 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,774,554 ("*Gilham*") in view of U.S. Patent No. 6,772,130 ("*Karbowsk*"); rejected claims 7, 19, 30, 42, 53, 65, 76, and 88 under 35 U.S.C. § 103(a) as being unpatentable over *Gilham* and *Karbowsk* in further view of U.S. Patent No. 6,385,504 ("*Pintsov*"); and rejected claims 13-18, 21, 36-40, 44, 59-64, 67, 82-87, and 90 under 35 U.S.C. § 103(a) as being unpatentable over *Gilham* in view of *Karbowsk*, in further view of Official Notice.

By this response, Applicant has amended claims 1, 24, 47, and 70. No new matter has been added. Claims 1-92 remain pending and under examination.

#### **Rejections of Claims 1-92 under 35 U.S.C. § 103(a)**

Applicant respectfully traverses the rejection of claims 1-92 under 35 U.S.C. § 103(a) as being unpatentable over *Gilham* in view of *Karbowsk* or over *Gilham* and *Karbowsk* in further view of *Pintsov* or Official Notice. A *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. ... [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "The mere fact that references *can* be combined or modified does not render the resultant

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03. “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences *themselves* would have been obvious, but whether the claimed invention *as a whole* would have been obvious.” M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). ... The factual inquiries ... [include determining the scope and content of the prior art and] ... [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

A *prima facie* case of obviousness has not been established at least because the cited references and Official Notice fail to teach or suggest all the elements of independent claim 1, as amended. Amended claim 1 recites, among other things, “transmitting, to a sender's computing device, verification data configured to be included in a delivery payment coding,” “obtaining, using the computer system, data from the item, wherein the data is distinct from the verification data,” “obtaining, using the computer system, data from a verification database using the verification data as an index, wherein the data is distinct from the verification data,” and “comparing, using the

computer system, the data obtained from the item to the data obtained from the verification database.”

The Examiner alleged that the authentication code of *Gilham* constitutes verification data. O.A. at 2, 3. However, this is not correct. The authentication code of *Gilham* is not transmitted to a sender’s computing device, as recited in amended claim 1. Rather, the authentication code of *Gilham* is generated at the sender’s computer. See, *Gilham*, Fig. 2, item 18; col. 2:2-3; col. 3:66-4:3. Furthermore, the authentication code of *Gilham* is not configured to be included in a delivery payment coding, as recited by claim 1. Rather, the authentication code is printed by the destination address and is used to verify that the destination post code from the printed destination address matches the destination post code used to generate the authentication code. *Gilham*, col. 4:20-30; Fig. 1, item 33. The authentication code of *Gilham* simply has no relation to the delivery payment coding.

Indeed, *Gilham* discloses that the transaction identity number is sent to the sender’s device. *Gilham*, col. 1:45-46. The Examiner alleged that the transaction identity number of *Gilham* constitutes “data from the item, wherein the data is distinct from the verification data,” as recited in claim 1. However, in the Final Office Action mailed March 3, 2010 (“Final O.A.”), the Examiner stated that the “transaction identity number, . . . is the essential part of authentication code or verification data.” Final O.A. at p. 2. Indeed, in the present Office Action the Examiner states “the transaction identity number is the decrypted verification data” and constitutes “verifying the authenticity of the delivery payment coding using the verification data.” O.A. at 4 (emphasis added). The transaction identifier cannot be both “distinct from” and “essential” to the verification

data. This inconsistent treatment of the transaction identifier of *Gilham* cannot support the rejection of claim 1.

Additionally, the Office Action suggests that the authentication code, which the Office Action alleges constitutes verification data, could be used to index a database to obtain the transaction identification number. O.A. at 3. This is incorrect. As described above, the authentication code of *Gilham* is completely unrelated to the transaction identifier and used for an entirely different purpose. While *Gilham* discloses that the authentication code is unique to a sender, it is not unique to a mailpiece. In particular, *Gilham* discloses that the authentication code is based on the destination post code and an identity number of the sender. *Gilham*, col. 3:67-col.4:7. Thus, if two mailpieces were sent to the same post code using the same identity number, the authentication code would be the same. The Office Action's allegation that a transaction identity number could be retrieved using the authentication code of *Gilham* is the type of unsupported conclusory statement prohibited by the M.P.E.P. "[T]he legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142.

For at least the reasons cited above, *Gilham* fails to disclose or suggest "transmitting, to a sender's computing device, verification data configured to be included in a delivery payment coding," "obtaining, using the computer system, data from the item, wherein the data is distinct from the verification data," "obtaining, using the computer system, data from a verification database using the verification data as an index, wherein the data is distinct from the verification data," and "comparing, using the computer system, the data obtained from the item to the data obtained from the verification database."

*Karowski* fails to cure the defects of *Gilham*. The Office Action does not allege that *Karowski* discloses these elements of claim 1. The Office Action cited *Karowski* for allegedly disclosing "collecting electronic notification information from a sender," "updating the verification database with a time or location of the item in the item delivery system," and "using the electronic notification information to electronically transmit to the sender a notice containing the time or the location of the item in the item delivery system." O.A. at 3. Even assuming the Office Action's characterization of *Karowski* is correct, which Applicant does not concede, *Karowski* still fails to disclose or suggest "transmitting, to a sender's computing device, verification data configured to be included in a delivery payment coding," "obtaining, using the computer system, data from the item, wherein the data is distinct from the verification data" and "obtaining, using the computer system, data from a verification database using the verification data as an index, wherein the data is distinct from the verification data," and "comparing, using the computer system, the data obtained from the item to the data obtained from the verification database," or anything similar in concept.

*Pintsov* also fails to teach or suggest the above-recited elements of amended claim 1. The Examiner cited *Pintsov* as a teaching that the item delivery system comprises the United States Postal Service and that an update indicates that the verification data has been used. O.A. at 7. Assuming, without conceding, this characterization of *Pintsov*, *Pintsov* still fails to cure the deficiencies of *Gilham* and *Karowski*, discussed above. That is, *Pintsov*, also, fails to teach or suggest "transmitting, to a sender's computing device, verification data configured to be included in a delivery payment coding," "obtaining, using the computer system, data from the

item, wherein the data is distinct from the verification data" and "obtaining, using the computer system, data from a verification database using the verification data as an index, wherein the data is distinct from the verification data," and "comparing, using the computer system, the data obtained from the item to the data obtained from the verification database," as recited in claim 1.

Lastly, Official Notice fails to compensate for the deficiencies of *Gilham*, *Karbowksi*, and *Pintsov*. Indeed, the Office Action does not allege that Official Notice discloses or suggests these elements of claim 1. Even assuming that the Official Notice is properly taken, which Applicants do not concede, Official Notice fails to cure the deficiencies of *Gilham*, *Karbowksi*, and *Pintsov*, discussed above. That is, Official Notice does not disclose or suggest "transmitting, to a sender's computing device, verification data configured to be included in a delivery payment coding," "obtaining, using the computer system, data from the item, wherein the data is distinct from the verification data" and "obtaining, using the computer system, data from a verification database using the verification data as an index, wherein the data is distinct from the verification data," and "comparing, using the computer system, the data obtained from the item to the data obtained from the verification database," as recited by amended claim 1.

In view of the above, the Examiner has neither properly determined the scope and content of the prior art nor ascertained the differences between the claimed invention and the prior art. Moreover, the Examiner has provided no motivation for one of ordinary skill in the art to modify the teachings of the prior art to achieve the claimed combinations. Accordingly, no reason has been articulated as to why one of skill in the

art would find the claimed combination obvious in view of the prior art. For at least this reason, no *prima facie* case of obviousness has been established. The rejection of claim 1 under 35 U.S.C. § 103(a) is thus improper and should be withdrawn.

Amended independent claims 24, 47, and 70, although different in scope, contain similar recitations as those discussed above regarding amended claim 1. For at least the reasons discussed above with regard to claim 1, the Office Action does not establish a *prima facie* case of obviousness with respect to amended independent claims 24, 47, and 70, these independent claims are allowable, and Applicant respectfully requests the Examiner withdraw the section 103 rejections of these claims.

Furthermore, because a *prima facie* case of obviousness has not been made for independent claims 1, 24, 47, and 70, a *prima facie* case of obviousness has also not been established for claims 2-23, 25-46, 48-69, and 71-92, by virtue of their dependence on the independent claims. Thus, dependent claims 2-23, 25-46, 48-69, and 71-92 are allowable at least by virtue of their dependence from allowable independent claims, as well as by reason of reciting additional elements not taught or suggested by the cited references. Accordingly, Applicant respectfully requests the Examiner withdraw the rejection of claims 1-92 under 35 U.S.C. § 103(a) and allow the pending claims.

### **CONCLUSION**

If the Examiner believes that a conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicant's undersigned attorney at (571) 203-2430.

Please grant any extensions of time required to enter this Response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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